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1626

PATENT
Customer No. 22,852
Attorney Docket No. 07579.0014-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
HEATON et al.) Group Art Unit: 1626
Application No.: 09/889,701) Examiner: Golam M. SHAMEEM
Filing Date: November 5, 2001)
For: PRODUCTION OF ISOFLAVONE)
DERIVATIVES)

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

NOTICE REGARDING RELATED LITIGATION

Applicants hereby notify the U.S. Patent and Trademark Office that two patents possibly related to the present application are involved in litigation. The present application, Serial No. 09/889,701, is a §371 filing of PCT/AU00/00103, international filing date of February 15, 2000, which entered the national stage on November 5, 2001. Although the instant application and the patents in suit do not share a common specification or overlapping claims to priority, in the utmost of caution, the Applicants submit this notice in the event that the disclosures in the respective specifications would be considered related. Application Serial No. 09/889,701 is assigned to Novogen Pty. Ltd. ("Novogen").

SOLAE I

On June 3, 2003, Solae, L.L.C. ("Solae") filed a Complaint alleging that Archer Daniels Midland Company ("ADM") and Amerifit Nutrition, Inc. ("Amerifit") infringe at least one claim of

U.S. Patent No. 6,562,380 ("the '380 patent.") The case, Civil Case No. 4:03-CV-00732-HEA, was filed in U.S. District Court for the Eastern District of Missouri ("Solae I"). The undersigned has been informed that Solae is the exclusive licensee of '380 patent for products containing soy-derived isoflavones. The '380 patent issued from U.S. application Serial No. 08/910,837 on May 13, 2003, originally filed on August 13, 1997, which was a continuation of U.S. Application Serial No. 08/338,567, filed January 12, 1995, now U.S. Patent No. 5,830,887.

On July 3, 2003, ADM filed a motion to dismiss. On July 11, 2003, Amerifit filed a motion to dismiss. On August 11, 2003, Solae filed a response to the motions to dismiss. On August 14, 2003, Amerifit and ADM filed replies to Solae's response to the motions to dismiss. On August 26, 2003, Solae filed a sur-reply to the motion to dismiss. In November and December of 2003, additional documents were filed with the court relating to a motion to consolidate the case with Solae II, described below. On March 11, 2004, the Court issued a Memorandum and Order denying defendants ADM and Amerifit's Motions to Dismiss for Lack of Standing and Failure to Join an Indispensable Party. On March 18, 2004, Defendants ADM and Amerifit filed a Motion for Reconsideration of this order. On April 1, 2004, defendants ADM and Amerifit both filed Answers and Counter Claims to Plaintiff's Complaint. In these Answers, ADM and Amerifit denied the allegations contained in Solae's complaint. ADM and Amerifit asserted the affirmative defenses of invalidity and non-infringement of the '380 patent. ADM and Amerifit also presented counter-claims asking to declare the '380 patent invalid and non-infringed. On April 21, 2004, plaintiff Solae filed Replies to the Answers and Counterclaims of both defendants, ADM and Amerifit. In these Replies, Solae denied the defendants' allegations. On April 26, 2004, Solae, ADM and Amerifit filed Joint Motion to Consolidate Cases. This motion was granted on April 28, 2004, consolidating Solae I and Solae II cases for all purposes. All further pleadings will be filed in Solae I case.

Further to this Notice, the Applicants attach: the Complaint, the Memorandum and Order Denying ADM's Motion To Dismiss For Lack Of Standing And Failure To Join An Indispensable Party; Defendants Archer Daniels Midland Company And Amerifit Nutrition, Inc.'s Motion For Reconsideration; Defendant, Amerifit Nutrition, Inc.'s Answer and Counter Claims to Plaintiff's Complaint; Defendant, Archer Daniels Midland Company's Answer And Counter Claims to Plaintiff's Complaint; Plaintiff's Reply to Answer and Counterclaims of Defendant Archer Daniels Midland Company; Plaintiff's Reply to Answer and Counterclaims of Defendant Amerifit Nutrition, Inc.; and the docket for this case, current as of May 6, 2004.

SOLAE II

On November 4, 2003, Solae filed a Complaint alleging that ADM and Amerifit infringe at least one claim of the U.S. Patent No. 6,642,212 B1 ("the '212 patent.") The case, Civil Case No. 4:03-CV-01595 RWS, was filed in U.S. District Court for the Eastern District of Missouri ("Solae II"). The undersigned has been informed that Solae is the exclusive licensee of the '212 patent for products containing soy-derived isoflavones.

The '212 patent issued from U.S. application Serial No. 09/421,069 on November 4, 2003, and was originally filed on October 19, 1999, as a continuation of U.S. application Serial No. 08/910,837, filed August 13, 1997, now U.S. Patent No. 6,562,380 B1.

On November 21, 2003, ADM and Amerifit filed Defendants' Joint Motion to Consolidate. In their motion, Defendants requested consolidation of the litigation of '212 patent with the litigation of '380 patent described above. On December 29, 2003, Solae filed a First Supplemental Complaint against all defendants alleging that ADM and Amerifit infringe at least one claim of the '212 Patent. In this Complaint, Solae also alleges that defendants infringe at least one claim of U.S. Patent No. 6,664,382 ("the '382 patent"). On January 29, 2004, plaintiff Solae filed a Second Supplemental Complaint alleging that ADM and Amerifit infringe at least one

claim of the '212 Patent, and the '382 patent. In this Complaint, Solae added infringement of U.S. Patent No. 6,680,381 ("the '381 patent") to its allegations. On April 1, 2004, defendants ADM and Amerifit both filed Answers and Counter Claims to Plaintiff's Second Supplemental Complaint. In these Answers, ADM and Amerifit denied the allegations contained in Solae's second supplemental complaint. ADM and Amerifit asserted the affirmative defenses of invalidity and non-infringement of the '212 patent, the '382 patent and the '381 patent. ADM and Amerifit also presented counterclaims asking to declare the '212 patent, the '382 patent, and the '381 patent invalid and non-infringed. On April 21, 2004, Plaintiff Solae filed Replies to the Answers and Counterclaims of both defendants, ADM and Amerifit. In these Replies, Solae denied the defendants' allegations. On April 26, 2004, Solae filed Third Supplemental Complaint adding an allegation of infringement of U.S. Patent No. 6,706,292 ("the '292 patent") to the earlier presented allegations of infringement of the '212, the '382 and the '381 patents. On April 28, 2004, the Solae II case was consolidated with Solae I litigation as mentioned above.

Further to this Notice, the Applicants attach plaintiff Solae's Complaint, First Supplemental Complaint, and Second Supplemental Complaint; Defendant, Amerifit Nutrition, Inc.'s Answer And Counter Claims to Plaintiff's Second Supplemental Complaint; Defendant, Archer Daniels Midland Company's Answer and Counter Claims to Plaintiff's Second Supplemental Complaint; Plaintiff's Reply to Answer and Counterclaims of Defendant Archer Daniels Midland Company; Plaintiff's Reply to Answer and Counterclaims of Defendant Amerifit Nutrition, Inc.; Plaintiff Solae, LLC's Third Supplemental Complaint and the docket for this case, current as of May 6, 2004.

REMARKS

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 13, 2004

By: Jean Burke Fordis
Jean Burke Fordis
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